The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte HARALD MERTES, JOSEF PEDAIN and REINHARD HALPAAP

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Appeal No. 1998-3145
Application 08/432,285

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ON BRIEF

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Before OWENS, JEFFREY T. SMITH and PAWLIKOWSKI, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1-8, which are all of the claims in the application.

THE INVENTION

The appellants' claimed invention is directed toward a process for making a polyisocyanate containing allophanate

groups and to a coating composition containing this polyisocyanate.

Claims 1 and 5 are illustrative:

1. A process for the production of a polyisocyanate containing allophanate groups and in which the isocyanate groups consist essentially of aliphatically and/or cycloaliphatically bound isocyanate groups which comprises reacting an organic compound containing urethane groups with an organic polyisocyanate containing aliphatically and/or cycloaliphatically bound isocyanate groups in the presence of a tin compound.

5. A coating composition comprising an isocyanate-reactive component and the polyisocyanate prepared in accordance with Claim 1.

THE REFERENCES

Windemuth et al. (Windemuth)	3,769,318	Oct. 30, 1973
Verheist et al. (Verheist) (European patent application)	0 393 903	Oct. 24, 1990

THE REJECTION

Claims 1-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Verheist in view of Windemuth.

OPINION

We reverse the aforementioned rejection.

Verheist discloses a process for making a polyisocyanate composition which contains at least 80 wt% of aromatically bound isocyanate groups and can contain allophanate groups (page 2, lines 22 and 42-46; page 5, lines 18-21 and 39-48), wherein the catalyst can be a tin compound such as dibutyltin dilaurate (page 6, lines 8-9).

Windemuth discloses a process for making allophanate polyisocyanates containing at least one aromatically bound isocyanate group (col. 2, lines 63-65), wherein the catalyst can be tin(II) octoate (col. 6, lines 37-39).

The appellants' claims require that the isocyanate groups consist essentially of aliphatically and/or cycloaliphatically bound isocyanate groups. The term "consisting essentially of" includes not only what is specifically recited in the appellants' claim, but also any other materials which do not materially affect the basic and novel characteristics of the claimed invention. *See In re Herz*, 537 F.2d 549, 551-2, 190 USPQ 461, 463 (CCPA 1976); *In re De Lajarte*, 337 F.2d 870, 873-4, 143 USPQ 256, 258 (CCPA 1964); *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963).

The appellants' specification indicates that the basic and novel characteristics of their process and coating composition are low color value, high light and color stability, and comparatively low viscosity of the polyisocyanate (page 3, line 28 - page 4, line 2). Verheist indicates that the basic and novel characteristic of his polyisocyanates is their usefulness

for making flexible foams having low density, high resilience and high tear strength (page 2, lines 47-50). Windemuth indicates that the basic and novel characteristic of his process is the production of allophanate polyisocyanates which are free of secondary products having isocyanurate structures (col. 1, lines 15-21). Windemuth discloses a low viscosity of his polyisocyanates (examples 3, 5, 7 and 8), but neither Windemuth nor Verheist mention the color value and light and color stability of their polyisocyanates.

The examiner does not argue that the applied references indicate that the aromatically bound isocyanates in the polyisocyanate of each reference would not materially affect

the basic and novel characteristics of the appellants' claimed process and composition. The examiner apparently is of the view that it was well known in the art that aliphatically bound polyisocyanates have better color stability, which is important for clear coatings, than aromatically bound polyisocyanates, and that it therefore would have been obvious to one of ordinary skill in the art to eliminate Wildemuth's at least one aromatically bound isocyanate group to obtain better color

stability. The examiner makes no argument that the appellants' "consisting essentially of" language fails to exclude Verheist's polyisocyanates which must contain at least 80 wt% of aromatically bound isocyanate groups (page 5, lines 18-21).

In order for a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. *See In re Rinehart*, 531 F.2d 1048,

1051, 189 USPQ 143, 147 (CCPA 1976). The mere fact that the prior art could be modified as proposed by the examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Windemuth teaches that his process produces allophanate polyisocyanates containing at least one aromatically bound isocyanate group and that the polyisocyanates so produced have the property of being free of secondary products having isocyanurate structures (col. 1, lines 15-23). The examiner does not explain why one of ordinary skill in the art would have expected the absence of secondary products having isocyanurate

structures to be obtained if the polyisocyanate did not have at least one aromatically bound isocyanate group, or why one of ordinary skill in the art would have been led by the references themselves to modify Windemuth's process such that the composition produced has no aromatically bound isocyanate

groups

but also does not have the desired absence of secondary products having isocyanurate structures.

Because the examiner has not established that the appellants' "consisting essentially of" language fails to exclude the aromatically bound isocyanate groups of Verheist or Windemuth, or explained why the applied references would have fairly suggested, to one of ordinary skill in the art, making a polyisocyanate which does not include the aromatically bound isocyanate groups of Verheist or Windemuth, the examiner has not carried the burden of establishing a *prima facie* case of obviousness of the invention recited in any of the appellants' claims. Accordingly, we reverse the examiner's rejection.

DECISION

The rejection of claims 1-8 under 35 U.S.C. § 103 over Verheist in view of Wildemuth is reversed.

REVERSED

TERRY J. OWENS Administrative Patent Judge	)
JEFFREY T. SMITH Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	)

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